

AF
JTW

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

10

Application Number 09/143,967

Filing Date August 31, 1998

First Named Inventor Bertram et al.

Art Unit 2179

Examiner Name B. Huynh

Attorney Docket Number RP9-95-017V

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		
<input type="checkbox"/> Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Winstead Sechrest & Minick P.C.		
Signature			
Printed name	Robert A. Voigt, Jr.		
Date	November 2, 2004	Reg. No.	47,159

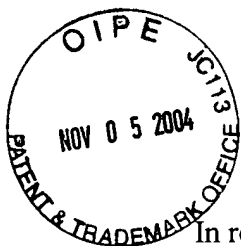
CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Serena Beller	Date	November 2, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Bertram et al.	:	Huynh, B.
Serial No.: 09/143,967	:	Group Art Unit: 2179
Filed: August 31, 1998	:	
Title: MOBILE CLIENT COMPUTER	:	IBM Corporation
PROGRAMMED TO PREDICT INPUT	:	P.O. Box 12915
	:	Dept. 9CCA, Bldg. 002
	:	Research Triangle Park, NC 27709

November 2, 2004

REPLY BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated October 20, 2004, with a one-month statutory period for response set to expire on November 20, 2004.

CERTIFICATION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 2, 2004.



Signature

Serena Beller

(Printed name of person certifying)

I. RESPONSE TO EXAMINER'S ARGUMENTS

- A. Response to Examiner's argument, as discussed on pages 10-11 of Examiner's Answer, that Capps and Hoffberg, taken together, teach or suggest "exercising the predictive widget to supply a predictive default entry for the defined data field, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field" as recited in claim 38 and similarly in claims 50 and 62.

The Examiner asserts that Hoffberg teaches the limitation of "exercising the predictive widget to supply a predictive default entry for the defined data field, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field." Examiner's Answer, page 10. Appellants respectfully traverse. The Examiner cites column 51, lines 62-66; column 77, lines 55-67; and column 81, lines 14-17 of Hoffberg as teaching the above-cited claim limitations. Examiner's Answer, pages 10-11. However, these passages teach that a most probable choice is presented to the user for his approval or another alternative choice may be selected. Hoffberg further teaches that its system "fills in the blank". Column 81, lines 13-21. Hoffberg's use of the phrase "fills in the blank" was not referring to filling in a data field but instead was referring to making a prediction for a user. There is no language in the cited passages of Hoffberg that teaches presenting the most probable choice to a user for a defined data field where the defined data field is filled with the most probable choice prior to a user entering a character in the defined data field. This is required by the recited claim language. The Examiner cannot ignore claim language, namely supplying a predictive default entry for the defined data field where the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. §2143.03. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 38, 50 and 62, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

- B. Response to Examiner's argument, as discussed on pages 7-9 of Examiner's Answer, that the Examiner did present objective evidence and appropriate motivation for combining Capps with Hoffberg.

The Examiner asserts that Appellants argued in Appellants' Appeal Brief that the motivation to combine is suggested from the secondary reference. Examiner's Answer, page 7. Appellants respectfully traverse. Appellants instead asserted in Appellants' Appeal Brief that the Examiner did not provide an appropriate motivation as the motivation provided by the Examiner (column 77, lines 60-63 of Hoffberg) was not a motivation to combine Capps and Hoffberg but a motivation to solve the problem presented by Hoffberg. Thus, the Examiner's motivation was insufficient to establish a *prima facie* case of obviousness, and thus claims 38, 39, 50, 51, 62, 63 and 73-79 are patentable over the cited art. M.P.E.P. §2143.

Further, the Examiner cites *In re Kunderna*, 165 U.S.P.Q. 575 (C.C.P.A. 1970) as support for the assertion that obviousness is not determined in view of the first reference and then another reference. Examiner's Answer, page 7. Appellants respectfully assert that *In re Kunderna* stands for the proposition that the Examiner must provide evidence as to why one of ordinary skill in the art would emphasize an isolated teaching. *In re Kunderna*, 165 U.S.P.Q. 575, 578-79 (C.C.P.A. 1970). The Examiner must present objective evidence as to why one of ordinary skill in the art with the Capps reference in front of him would have been motivated to combine Capps with Hoffberg, the secondary reference. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002); *See In re Kunderna*, 165 U.S.P.Q. 575, 579 (C.C.P.A. 1970). The Examiner simply says that the references, Capps and Hoffberg, may be viewed together but does not present any motivation as to why one of ordinary skill in the art would combine these references. This is insufficient to establish a *prima facie* case of obviousness, and thus claims 38, 39, 50, 51, 62, 63 and 73-79 are patentable over the cited art. M.P.E.P. §2143.

Furthermore, Appellants agree with the Examiner's statement on page 8 of the Examiner's Answer that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated in the structure of the primary reference.

However, the claimed combination cannot change the principle of operation of the primary reference or render the primary reference inoperable for its intended purpose. M.P.E.P. §2145. As asserted by the Appellants on pages 9-10 of Appellants' Appeal Brief, the combination of Capps with Hoffberg changes the principle of operation of Capps and subsequently renders the operation of Capps to perform its purpose unsatisfactorily. Thus, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 38, 39, 50, 51, 62, 63 and 73-79, and thus claims 38, 39, 50, 51, 62, 63 and 73-79 are patentable over the cited art. M.P.E.P. §2143.

Furthermore, the Examiner asserts that both Capps and Hoffberg are directed to the particular problem of menu selection. Examiner's Answer, page 8. Appellants respectfully traverse the assertion. Hoffberg instead is directed to reducing the time necessary to communicate a desired action through an interface to a computerized device. Column 26, lines 32-34. Hoffberg attempts to reduce this limitation and make use of surplus processing capacity of the computer to predict a most likely input from the operator and present this as an easily available option. Column 26, lines 35-38. Hoffberg further teaches that the applications of its interface include a VCR, medical device, vehicle control system, audio device, environmental control system, securities trading terminal and smart-house. Abstract. Capps, on the other hand, is directed to improving the user interface that allows a user to enter data with a greater ease of use as lists provided to users are generally too long and requires a substantial amount of time for the user to identify the item to be selected. Column 2, lines 6-13. Hence, Hoffberg is not reasonably pertinent to the particular problem Capps was concerned and therefore a person of ordinary skill would not reasonably be expected to look at Hoffberg for a solution to the problem facing Capps. Thus, claims 38, 39, 50, 51, 62, 63 and 73-79 are patentable over the cited art. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992).

- C. Response to Examiner's argument, as discussed on pages 9-10 of Examiner's Answer, that Capps combined with Hoffberg would not change the principle of operation of Capps.

The Examiner asserts that Capps combined with Hoffberg would not change the principle of operation of Capps since the test for obviousness is not whether the features of a secondary reference may be bodily incorporated in the structure of the primary reference. Examiner's Answer, page 9. However, the claimed combination cannot change the principle of operation of the primary reference or render the primary reference inoperable for its intended purpose. M.P.E.P. §2145. The Examiner has not addressed the fact that the combination of Capps with Hoffberg changes the principle of operation of Capps. Therefore, claims 38, 39, 50, 51, 62, 63 and 73-79 are patentable over the cited art. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Furthermore, the Examiner must consider each reference in its entirety, i.e., as a whole, including portions of a secondary reference that would cause the primary reference to change its principle of operation. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 203 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. §2141.02. The Examiner cannot ignore teaching in the secondary reference Hoffberg. The Examiner cannot ignore that Hoffberg teaches that the applications for its interfaces are for VCRs, medical devices, vehicle control systems, audio devices, environmental control systems, securities trading terminals and smart houses. Abstract. Therefore, claims 38, 39, 50, 51, 62, 63 and 73-79 are patentable over the cited art. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

- D. Response to Examiner's argument, as discussed on page 10 of Examiner's Answer, that the Examiner has presented a reasonable expectation of success when combining Capps with Hoffberg.

The Examiner states that it would be apparent to one of ordinary skill in the art to combine Capps with Hoffberg and hence the Examiner has provided a reasonable

expectation of success in combining Capps with Hoffberg. Examiner's Answer, page 10. However, the Examiner has not provided any evidence as to how displaying a historical list to a user of a computer system (taught by Capps) would be combined with a VCR, a medical device, a vehicle control system, an audio device, an environmental control system, a securities trading terminal, or a smart house (taught by Hoffberg). Consequently, the Examiner has not presented a reasonable expectation of success in combining Capps with Hoffberg. Therefore, the Examiner has not provided a *prima facie* case of obviousness for rejecting claims 38, 39, 50, 51, 62, 63 and 73-79. M.P.E.P. §2143.02.

- E. Response to Examiner's argument, as discussed on pages 11-12 of Examiner's Answer, that Appellants asserted in Appellants' Appeal Brief that the motivation to combine Capps with Hoffberg and Miller must come from each of the individual references.

Appellants do not assert that motivation must come from each of the references used in an obviousness rejection. To establish a *prima facie* case of obviousness, the Examiner must provide objective evidence from the references themselves or from evidence of the level of skill in the art at the time of the invention that would suggest a motivation to combine Capps with Hoffberg and Miller. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner's motivation to combine Capps with Hoffberg and Miller is a restatement of the limitation in claim 73. This is not evidence of motivation from either the references themselves or from the knowledge generally available to one of ordinary skill in the art. Consequently, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 73-79. M.P.E.P. §2143.

- F. Response to Examiner's assertion, as discussed on page 12 of Examiner's Answer, that references Capps and Miller are directed to the particular problem of menu selection.

The Examiner asserts that the references Capps and Miller are directed to the particular problem of menu selection. Examiner's Answer, page 12. Appellants respectfully traverse the assertion. Miller teaches that there is a need in the art for a text

prediction system that may operate with multiple applications with little or no application specific programming and that provides a fast search method for text in a text history array. Column 2, lines 40-43. Capps, on the other hand, is directed to improving the user interface that allows a user to enter data with a greater ease of use as lists provided to users are generally too long and requires a substantial amount of time for the user to identify the item to be selected. Column 2, lines 6-13. Hence, Miller is not reasonably pertinent to the particular problem Capps was concerned and therefore a person of ordinary skill would not reasonably be expected to look at Miller for a solution to the problem facing Capps. Thus, claims 73-79 are patentable over the cited art. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992).

- G. Response to Examiner's argument, as discussed on pages 12-13 of Examiner's Answer, that Capps, Hoffberg and Miller, taken in combination, teach or suggest "circuitry operable for predicting a default user's choice in an entry in said form prior to said user enters a character in said entry" as recited in claim 73.

The Examiner asserts that Appellants are showing non-obviousness by attacking the references individually. Examiner's Answer, page 13. Appellants respectfully assert that Appellants have not attacked the references individually. Instead, Appellants have shown (pages 16-17 of Appellants' Appeal Brief) that Capps, Hoffberg or Miller, taken singly or in combination, do not teach or suggest predicting a default user's choice in an entry in a form prior to the user entering a character in the entry. In order to establish a *prima facie* case of obviousness, the Examiner must provide prior art references that teach or suggest all of the claim limitations. M.P.E.P. §2143. The Examiner has not provided prior art references that teach or suggest predicting a default user's choice in an entry in a form prior to the user entering a character in the entry. Thus, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 73-79. M.P.E.P. §2143.

Furthermore, the Examiner has not provided any motivation for modifying Capps to predict a default user's choice in an entry in a form prior to the user entering a

character in the entry, as recited in claim 73. In order to establish a *facie* case of obviousness, the Examiner must present some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Capps to predict a default user's choice in an entry in a form prior to the user entering a character in the entry, as recited in claim 73. M.P.E.P. §2143. Since the Examiner has not provided such motivation, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 73-79. M.P.E.P. §2143.

H. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellants' Appeal Brief and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION

For the reasons stated in Appellants' Appeal Brief and noted above, Appellants respectfully assert that the rejections of claims 38, 39, 50, 51, 62, 63 and 73-79 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 38, 39, 45, 46, 50, 51, 57, 58, 62, 63, 69, 70 and 73-79.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By: 

Robert A. Voigt, Jr.

Reg. No. 47,159

Kelly K. Kordzik

Reg. No. 36,571

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

Austin_1 265230v.1